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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,907	05/30/2001	David Blight	035451-0122 (3605.Palm)	7557
26371	7590	01/03/2006	EXAMINER	
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			SHARMA, SUJATHA R	
			ART UNIT	PAPER NUMBER
			2684	

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/867,907	<b>Applicant(s)</b> BLIGHT, DAVID	
	<b>Examiner</b> Sujatha Sharma	<b>Art Unit</b> 2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/17/01</u> . | 6) <input type="checkbox"/> Other: _____  |

**AFFIDAVIT AND DECLARATION**

1. The declaration filed on 11/12/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Parry reference due to missing signature.
2. However, upon approval of the petition under 37 CFR 1.47(a), it is suggested that the applicant resubmit the declaration under 37 CFR 1.131.

***Response to Amendment***

3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Parry reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).
4. The office has not received the following papers, as indicated by the applicant in the unsigned declaration, as evidence of conception before the effective date of the Parry reference.
  - a) A copy of an electronic mail message dated February 22, 2001 from Senior Patent Attorney Henry Ohab of Palm, Inc. to Alistair Chan of Foley & Lardner LLP. The message had attached an Invention Disclosure Form and a document describing the subject matter of the '907 application.
  - b) A copy of the Invention Disclosure Form referred to in a), indicating a date of conception of January 30, 2001 on page 2, section 3.

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c) A copy of the document referred to in a) describing the subject matter of the &907 application.

Therefore in view of the above arguments, the prior art still applies and the rejection discussed in the previous office action mailed 5/27/04 and as discussed below is considered proper.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6,11,17 recites the limitation "the estimated position" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Further claim, 6,11,17 are directed to sending a reply to the location service indicating an incorrect estimated position. However it is unclear how this determination is performed. In order to determine that the estimated position is incorrect, there is a need for a comparative element and the claims do not provide for this comparative element.

***Claim Rejections - 35 USC § 102***

1. Claim 1-5,7-10,12-16,18-24 is rejected under 35 U.S.C. 102(b) as being anticipated by Dussell [US 5,938,721].

Regarding claims 1,7,12,18,24, Dussell discloses a method of using positioning systems to control access to computer databases to assist in task scheduling. Dussell further discloses a method of

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- gathering a list of addresses of nearby devices in communication with a network; see col.1, lines 58-61, col. 3, lines 27-32, col. 7, lines 28-32, col. 9, lines 3-16
- sending a location request to location service accessible through the network accessed wirelessly by the mobile device; see col. 5, lines 53- 65,
- accessing a database of known device; see col. 1, lines 59-63, col. 5, lines 27-35, col. 7, lines 42-51, col. 9, lines 3-16
- correlating the list of addresses with zone information of the database; see col. 3, lines 27-39, col. 8, lines 12-44, col. 9, lines 38 - 49

Regarding claim 2, Dussell further discloses a method of receiving from the location service an estimated position of the mobile device. See col. 5, line 53 – col. 7, line 3.

Regarding claims 3,8,13, Dussell further discloses a method wherein the location information includes a text-based description. See col. 2, lines 3-9, col. 4, lines 38-40, col. 9, line 66 – col. 10, line 3.

Regarding claims 4,9,15, Dussell discloses a method of providing an approximate position of the mobile device to the location service. See col. 8, lines 50-58 (where the current position of the mobile device is within 100-1600m thus indicating an approximate position of the mobile unit relative to the requested point of interest].

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Regarding claims 5,10,16, Dussell further discloses a method wherein the approximate position is determined by a global positioning system (GPS) device. See col. 3, lines 36 – 39.

Regarding claim 14, Dussell further discloses a method wherein the location estimation includes a graphical description of the mobile device location. See col. 9, line 66 – col. 10, line 3.

Regarding claim 23, Parry discloses a method wherein the estimated position of the wireless device is provided on a graphical map. See col. 9, line 66 – col. 10, line 3.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dussell [US 5,938,721] in view of Parry [2002/0164997].

Regarding claim 19, Dussell discloses all the limitations as claimed. However, he does not disclose a method of including a bluetooth transceiver in the wireless device.

Parry, in the same field of endeavor, teaches the use of bluetooth transceiver in the wireless device. See page 3, paragraph 28.

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Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Parry to Dussell in order to provide wireless interconnectivity of a wide range of devices without the use of cables.

Regarding claim 20, Parry further discloses the wireless device to include an IEEE 802.11 transceiver. See page 3, paragraph 28.

Regarding claim 21, Parry discloses a method wherein the at least one other device includes a printer. See page 2, paragraph 26.

Regarding claim 22, Parry discloses a method wherein the at least one other device includes a computer. See page 2, paragraph 27.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Hamaguchi [US 2002/0010617] Member registration system

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sujatha Sharma whose telephone number is 703-305-5298. The examiner can normally be reached on Mon-Fri 7.30am - 4.00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sujatha Sharma  
December 19, 2005

EDAN ORGAD  
PATENT EXAMINER/TELECOMM.

*E.O.* 12/19/05